

REMARKS

Reconsideration of this application is respectfully requested. Claims 1-5 and 11-25 are pending in this application. Claims 1-5 and 11-25 stand rejected.

Claim Rejection-35 U.S.C. §103

Claims 1-5 and 11-25 were rejected under 35 U.S.C. §103 as being unpatentable over **Thibadeau** (USP 5,565,909, previously cited) in view of **Zigmond** (USP 6,698,020, previously cited). For the reasons set forth in detail below, this rejection is respectfully traversed.

Initially, it is noted that the **Thibadeau** and **Zigmond** references have been previously applied against the claims. Specifically, the **Thibadeau** reference was been applied as the primary reference in all of the previous Office Actions. The **Zigmond** reference was applied against claims 21-25 in combination with **Thibadeau** and other references in past Office Actions.

The **Thibadeau** reference is applied against the claims in the same manner as in the previous Office Actions. More specifically, the Examiner's position is that **Thibadeau** discloses all claimed features, except "*judgment means for judging whether or not video and audio which are being currently outputted are a commercial (CM) appended to a program*" and "*wherein said controller feeds to said video/audio output means the advertising information selected by the contrast between the information related to the current position and the advertising area information in response to said judgment means judging that the video and audio which are currently being output are a commercial*". See Office Action, page 4, lines 1-6.

As discussed in previous responses, applicant basically agreed with the Examiner regarding the deficiencies of **Thibadeau**.

A brief summary of the relevant teachings of the **Thibadeau** reference is provided below. **Thibadeau** discloses a set-top receiver that allows a user to enter a location designation code into a data processor attached to the receiver. The location designation code defines locations of interest selected by the user. A transmitter transmits messages or information including location designation codes accompanying location specific messages or information. The data processor attached to the receiver receives the transmitted message or information with the location designation code and compares the location designated by the location designation code with the locations of interest selected by the user. The data processor displays the messages or information when there is overlap between the location of interest selected by the user and the location designation code accompanying the message or information.

The **Zigmond et al.** reference discloses a method and system for selecting and inserting an advertisement into a video programming feed at the household level. According to **Zigmond et al.**, at an appropriate time specified by encoded data in a video programming feed 52 or by the structure of the video programming feed 52, a household advertising insertion device interrupts the display of the video programming feed and displays an advertisement 59 that has been selected according to any desired method (see, e.g., Fig. 3, and col. 7, lines 26-32).

As shown in Fig. 4, an advertisement insertion device 60 includes a video switch 68 that toggles between the video programming feed 52 from a programming source 66 and selected advertisements in an advertisement stream 64 from an advertisement source 62, and transmits the

selected data feed to a display device 58 (see col. 8, lines 33-36). The video switch 68 may be actuated at a time indicated by a triggering event, the triggering event indicating an appropriate time to insert a selected advertisement (col. 8, lines 36-38 and 51-54).

Zigmond et al. teaches that the triggering event indicating an appropriate time to insert a selected advertisement may be a black screen preceding the onset of a series of advertisements (col. 8, lines 48-54). The Examiner considers the triggering event being a black screen to correspond to the claimed *“judgment means for judging whether or not video and audio which are being currently outputted are a commercial (CM) appended to a program”*.

The **Zigmond et al.** reference also teaches that the advertisement insertion device may include a storage device 82 that stores information, such as the geographical location of a household (see, e.g., col. 10, lines 30-33 and 55-58). More specifically, **Zigmond et al.** teaches that “ad selection criterion are stored in ad insertion device *for use in combination with viewer and system information 82 and/or the electronic program database 81 in order to select appropriate advertisements to be displayed to the viewer*” (see col. 11, lines 31-35 and also col. 12, lines 33-38).

However, as will be discussed in detail below, it is respectfully submitted that neither **Thibadeau** nor **Zigmond et al.** nor of the references disclose or suggest the claimed *“wherein said controller feeds to said video/audio output means the advertising information selected by the contrast between the information related to the current position and the advertising area information in response to said judgment means judging that the video and audio which are*

currently being output are a commercial.” Further, as will be discussed in detail below, it is respectfully submitted that there is no motivation or incentive for combining the references.

The Examiner recognizes that **Thibadeau** does not disclose the feature “*wherein said controller feeds to said video/audio output means...in response to said judgment means judging that the video and audio which are currently being output are a commercial.*” See Office Action, page 4, lines 3-6.

Zigmond et al. discloses that geographic information is used in combination with ad selection criterion to select appropriate advertisements to be displayed to a viewer. However, **Zigmond et al.** is silent with respect to selecting advertising information, in response to the judgment that the video and audio currently being output are a commercial, based on the contrast between information related to the current position *and the advertising area information [which is carried on the digital broadcasting wave]*.

Although **Zigmond et al.** discloses that geographic information is used to select an advertisement to be displayed to a viewer, **Zigmond et al.** *is silent with respect to how the geographic information is specifically used.* In particular, **Zigmond et al.** do not disclose or suggest that advertising area information, *which is carried on the broadcast wave*, is compared with the geographic information stored in storage device 82 to select advertising information that is output *in response to* the judgment that the video and audio which are currently being output are a commercial.

In other words, there is no disclosure in the **Zigmond et al.** reference that the action taken *in response to* detecting that a commercial is being output is to output advertising information

selected based on a contrast between advertising area information, *which is carried on a broadcast wave*, and information related to the current position.

It is noted that the **Thibadeau** reference does not disclose or suggest detecting whether a commercial is being output, and therefore does not disclose or suggest selecting advertising information in response thereto.

Furthermore, it is respectfully submitted that there is no teaching, suggestion or motivation to combine the references, as is required under §103. More specifically, the **Thibadeau** reference *is completely unrelated to detecting when a commercial is being broadcast*. The **Thibadeau** reference teaches distributing information, whether a commercial or local emergency warning or other information, by comparing the location designation code entered by a user to a set top box with a location designation code accompanying a broadcast message.

The **Zigmond et al.** reference teaches detecting a commercial in a broadcast. However, it is submitted that there is no teaching, suggestion or motivation in the references or in what is known in the art, to include detection of a commercial, as taught by **Zigmond et al.**, in the system of **Thibadeau**. The Office Action suggests that the motivation to combine the references is to “achieve targeted advertising geographically” (see page 4, lines 13-15 of Office Action).

However, the **Thibadeau** reference achieves receipt of a geographically targeted message by having the user enter a location designation code into the set top box. Therefore, it is submitted that **Thibadeau** achieves a geographically targeted message without having to judge whether or not video and audio which are currently being output are a commercial appended to a

Application No. 09/988,336
Art Unit: 2623

Request for Reconsideration under 37 CFR 1.111
Attorney Docket No.: 042206

program. Accordingly, it is submitted that the motivation for combining the references provided in the Office Action is not adequate to support the §103 rejection because the **Thibadeau** reference can achieve geographically targeted advertising without modification by the **Zigmond et al.** reference.

In view of the above remarks, reconsideration and withdrawal of the rejection of claims 1-5 and 11-25 under §103 are respectfully requested.

CONCLUSION

In view of the foregoing amendments and accompanying remarks, it is submitted that all pending claims are in condition for allowance. A prompt and favorable reconsideration of the rejection and an indication of allowability of all pending claims are earnestly solicited.

If the Examiner believes that there are issues remaining to be resolved in this application, the Examiner is invited to contact the undersigned attorney at the telephone number indicated below to arrange for an interview to expedite and complete prosecution of this case.

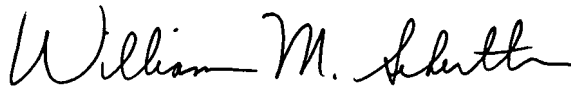
Application No. 09/988,336
Art Unit: 2623

Request for Reconsideration under 37 CFR 1.111
Attorney Docket No.: 042206

If this paper is not timely filed, Applicants respectfully petition for an appropriate extension of time. The fees for such an extension or any other fees that may be due with respect to this paper may be charged to Deposit Account No. 50-2866.

Respectfully submitted,

WESTERMAN, HATTORI, DANIELS & ADRIAN, LLP



William M. Schertler
Attorney for Applicants
Registration No. 35,348
Telephone: (202) 822-1100
Facsimile: (202) 822-1111

WMS/dlt